



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/358,653	07/23/1999	JOHN M. HILLMAN	CITI0092-US	1816

7590 01/11/2002

GEORGE T MARCOU
KILPATRICK STOCKTON LLP
700 13TH STREET NW
SUITE 800
WASHINGTON, DC 20005

EXAMINER

KYLE, CHARLES R

ART UNIT

PAPER NUMBER

2164

DATE MAILED: 01/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

GM

Office Action Summary

Application No.

09/358,653

Applicant(s)

HILLMAN ET AL.

Examiner

Charles Kyle

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As to Claims 1 and 2, they contain the phrase ""transferring the contribution amount to the financial amount". As well as lacking sufficient antecedent basis, it appears that the phrase "the financial amount" should read "the financial account".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shurling et al in view of Ferguson et al.

Regarding Claim 12, Shurling et al disclose the invention substantially as claimed including in a method for leveraging a financial relationship between multiple participants (Summary of the Invention), the steps of:

Determining a number of components comprising the financial relationship (Col. 9, line 51 to Col. 10, line 64);

Calculating an individual value for each of the components at the end of a set period of time (Col. 10, line 65 to Col. 12, line 56);

Multiplying the determined individual value of each of the individual components by a pre-selected percentage to obtain a total value award (Col. 11, line 58 to Col. 12, line 8, particularly Col. 11, lines 64-66);

Adding the total value account to a first financial account (Col. 13, line 62 to Col. 14, line 3).

While Shurling et al disclose many of the details of leveraging financial relationship between participants, they do not specifically disclose the claimed details of account transfers. Ferguson et al disclose these details in the same environment of leveraged financial relationships as Shurling et al as follows:

Holding the total value award in the first financial account under control of a first of multiple participants (Col. 7, lines 8-62; Fig 1, element 26);

Selecting a second financial account under the control of the first of the multiple participants into which the total award is to be transferred (Fig. 1, ele. 30);

Transferring the total value award into the second financial account (Fig. 1, ele. 28).

See also Ferguson et al, Brief Summary of the Invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the option of transferring award amounts in the fashion described in Ferguson et al in the financial leveraging system disclosed by Shuring et al because this would have provide a consolidated account for distribution of awards and would have facilitated tracking and auditing of accounts to which awards were made. It would further have been obvious to have utilized a predetermined delay for funds transfer in cases in which a minimum balance was required to open an account or "open season" timing concerns existed for account opening. Additionally, Shurling et al specifically disclose concerns with vesting of award amounts, which would entail predetermined periods for award grant.

Concerning Claim 13, Shurling et al disclose multiple participants at Col. 2, line 45 to Col. 3, line 36 and Abstract.

With respect to Claim 14, Shurling et al disclose the second participant as a customer at Summary of the Invention and Col. 2, line 45 to Col. 3, line 36.

Regarding Claim 15, Shurling et al disclose the first of multiple participants as a financial institution at Col. 2, line 45 to Col. 3, line 36.

Art Unit: 2164

As to Claim 16, Ferguson et al disclose the first financial account as a pooled account at Col. 10, lines 25-40. This pooled account is read as the equivalent of a saving account in that it "saves" award amounts for later distribution to customers.

As to Claim 17, Ferguson et al disclose the second financial account as a brokerage account at Col. 11, lines 23-35 and Fig. 1, ele. 30.

Concerning Claim 18, Ferguson et al disclose the brokerage account as a mutual fund at Col. 11, lines 29-31.

With respect to Claim 19, Ferguson et al disclose loan accounts, investment accounts and service accounts at Col. 1, lines 6-27.

With respect to Claim 20, Ferguson et al disclose a loan account as a mortgage at Col. 1, line 19.

With respect to Claim 21, Ferguson et al disclose an investment account as a CD at Col. 1, lines 19-20.

With respect to Claim 22, Ferguson et al disclose a service account as an insurance account at Col. 1, line 20.

As to Claim 1, see the discussion of Claim 12 above.

Regarding Claim 2, Shurling et al disclose a monthly updating of records on which awards were based at Col. 15, line 47 to Col. 16, line 31. This is read as functionally equivalent to a disbursement schedule.

Regarding Claims 3-5, see the discussion of Claim 12 above.

Art Unit: 2164

With respect to Claims 6-11, see the discussion of Claims 13-18 set forth above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,049,782 A

Gottesman et al

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kyle whose telephone number is (703) 305-4458. The examiner can normally be reached on Monday - Friday, 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

crk

crk

January 3, 2002


VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100